

## REMARKS

The Examiner is thanked for the interview of Oct. 7, 2003. In the interview, the 103 rejection based on Berube et al. (U.S. Pat. No.: 6,325,796) was discussed. In particular, that the rejection was improper. The Examiner tentatively agreed and requested that the Applicant submit a response. The Examiner also stated that a new search would probably be conducted. Claiming priority to Berube et al. (USPN 6,325,796) thus removing it as a reference under 102(e) was also discussed in the interview.

In the Office Action, the Examiner rejected claims 78-86 and 89-91 under 35 USC 112, claims 36, 41-44, 51 53, 57, 66, 67, 76 78-86, 89-91 and 100 under 35 USC 102 and claims 37-39 under USC 103. These rejections are fully traversed below.

Claims 78, and renumbered claims 100-104 have been amended. Thus, claims 36-39, 41-46, 51, 53, 57, 66, 67, 76, 78-86, 89-91 and 100-104 are pending in the application. Reconsideration of the application is respectfully requested based on the following remarks.

### *Claim Rejections – 35 USC § 112*

**Claims 78-86 and 89-91 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is believed that the rejection has been overcome by the amendments made above. In particular, the language “organ or duct” has been removed from claim 78.

### *Claim Objections*

The undersigned agrees with the Examiner. Misnumbered claims 92-96 have therefore been renumbered 100-104 as shown above.

### ***Claim Rejections – 35 USC § 102***

**Claims 36, 41-44, 51 53, 57, 66, 67, 76 and 100 have been rejected under 35 U.S.C. 102(e) as being anticipated by *Berube et al.* (USPN 6,325,796 B1).**

The present application is a continuation in part of *Berube* (6,325,796). See Specification Amendments above. *Berube* (6,325,796) is therefore not applicable as prior art and the rejection should be withdrawn. A terminal disclaimer has been filed herewith.

**Claims 78-86 and 89-91 have been rejected under 35 U.S.C. 102(e) as being anticipated by *Gough et al.* (USPN 5,863,290).**

In contrast to *Gough*, claim 78 (and its dependents) specifically requires, "...wherein said energy delivery portion is formed from a shape memory material that substantially conforms to an inner wall of a heart when positioned through a penetration in a wall of the heart." While *Gough* may disclose secondary electrode 16 made of shape memory metals such as NiTi, *Gough* does not teach or suggest a secondary electrode 16 that conforms to an inner wall of an organ or duct let alone a heart. In *Gough*, the curved shape of the secondary antenna would simply not conform to the surface of an inner wall. As such, the device of *Gough* is inadequate for effectively ablating a wall of an organ. Accordingly, the rejection is unsupported by the art and should be withdrawn.

### ***Claim Rejections – 35 USC § 103***

**Claims 37-39 have been rejected under 35 USC 103(a) as being unpatentable over *Berube et al.* (USPN 6,325,796 B1) in view of *Lundquist et al.* (USPN 5,531,677)**

It is respectfully submitted that the rejection is believed to be improper since the prior art reference *Berube* is disqualified as prior art against the claimed invention. MPEP 706.02(k) states, "Effective November 29, 1999, subject matter which was prior art under former 35 USC 103 via 35 USC 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." With regards to

these issues, *Berube* was filed on May 4, 1999 and issued on Dec. 4, 2001, and the present application was filed on September 29, 2000. Further, the present application was filed after November 29, 1999, and the undersigned expressly states that the subject matter of *Berube* and claimed invention were, at the time the invention was made, owned by or subject to an obligation of assignment to AFx, Inc., Fremont, CA (US). Accordingly, the Examiner is respectfully urged to remove the 103 rejection.

**Summary**

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read 'Q. Hoellwarth', with a long horizontal flourish extending to the right.

Quin C. Hoellwarth  
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